

REMARKS

Claims 1 through 16 are pending in this Application. Claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, page 11 of the written description of the specification, line 24 through page 12 thereof, line 2. Applicant submits that the present Amendment does not generate any new matter issue.

Claims 1 through 4 and 9 through 12 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Terazono et al.

In the statement of the rejection the Examiner adhered to the position that Terazono et al. disclose an electrode and fuel cell corresponding to those claimed. This rejection is traversed.

There is an fundamental difference between the claimed invention and the fuel cell and electrode disclosed by Terazono et al. that undermines the factual determination of lack of novelty under 35 U.S.C. § 102. Specifically, in accordance with the claimed invention, an electrode for a fuel cell is provided, which electrode comprises, *inter alia*, first and second carbon particles. The first carbon particles have a hydrophilic surface and the second carbon particles have a water-repellant surface. Further, claim 1 specifies that the content of the second carbon particles in the catalyst layer is in the range of about 10 wt.% to 50 wt.% with respect to the weight of the entire catalyst layer. No such electrode comprising a second carbon particle in the amount specified is disclosed or suggested by Terazono et al.

The above argued difference between the claimed invention and Terazono et al. is functionally significant. Specifically, as disclosed at page 11 of the written description of the specification, lines 24 through 27, with 10% or more of the second carbon particle, a gas

diffusion path and moisture discharging path can be effectively formed. Moreover, as disclosed at page 11 of the written description of the specification, line 27 through page 12 thereof, line 2, with 50 wt.% or less of the second carbon particle, since sufficient amounts of ion exchange resin and the first carbon particle supporting a catalytic material are contained in the catalyst layer, the catalytic reaction can be efficiently performed.

The above argued functionally significant difference between the claimed electrode and the electrode disclosed by Terazono et al. undermine the factual determination that Terazono et al. disclose an electrode, and hence a fuel cell containing such electrode, within the meaning of 35 U.S.C. § 102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claims 1 through 4 and 9 through 12 under 35 U.S.C. § 102 for lack of novelty as evidenced by Terazono et al. is not factually viable and, hence, solicits withdrawal thereof.

Claims 5 through 8 and 13 through 16 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Terazono et al. in view of Koschany et al.

This rejection is traversed. Specifically, claims 5 through 8 and 13 through 16 depend ultimately from independent claim 1. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Terazono et al. The secondary reference to Koschany et al. does not cure the previously argued deficiencies of Terazono et al. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicant does not agree that the

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requisite fact-based motivation has been established, the claimed invention would not result.

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

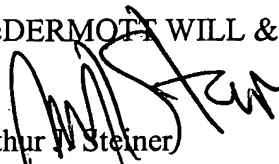
Applicant, therefore, submits that the imposed rejection of claims 5 through 8 and 13 through 16 under 35 U.S.C. § 103 for obviousness predicated upon Terazono et al. in view of Koschany et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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